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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/744,884 | 01/31/2001 | Jinichiro Kato | 01197.0224 | 6497 |

22852 7590 10/19/2004

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EXAMINER

CHANG, VICTOR S

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,884

Applicant(s)

KATO ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-3 is/are allowed.
- 6) ☒ Claim(s) 5-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Examiner has carefully considered Applicants' amendment and remarks filed on 9/20/2004.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

Rejections Based on Prior Art

4. Claims 5-7 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ash (US 5955019), generally as set forth in section 4 of Office action dated 4/19/2004, together with the following additional response to argument.

It is noted that independent claim 5 is amended to recite *inter alia* the weight ratio between the zinc halide to metal salt which is other than zinc halide(s) is 98/2 to 20/80, and a concentration of zinc halide(s) in the solvent is 20 to 70 wt%.

With respect to Applicants' argument "Ash clearly does not teach the claimed ratio of zinc halide to metal salt other than zinc halide ... The only thing that is taught [by Ash] is that the concentration of the salt in the solution ... when it is "ZnCl₂" ... greater than 61% ..." (Remarks, page 4, 3rd paragraph), the Examiner repeats (see page 2 of prior Office action dated 4/19/2004) that Ash expressly teaches that "The solvents useful in the process of this invention are comprised of ZnX₂ and LiY, wherein X is

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selected from the group consisting of Cl, Br, and I and Y is selected from the group consisting of Br, I, and SCN" (column 1, lines 56-60). Although Ash lacks an explicit teaching of a suitable weight ratio between the zinc halide to metal salt other than zinc halide, since Ash teaches the same subject matter (making filaments of polyketones from a solution of polyketones in a solvent comprising ZnX₂ and LiY), it is the Examiner's position that a suitable weight ratio between the zinc halide to metal salt other than zinc halide is either anticipated by Ash, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain a suitable solvent for making the polyketone filaments. It is *prima facie* obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. See MPEP § 2144.06. Additionally, it should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. Similarly, regarding the suitable amount of zinc halide(s) in a solvent comprising both zinc halide and metal salt other than zinc halide, in the absence of unexpected results, it is the Examiner's position that a suitable amount of zinc halide is also either anticipated by Ash, or an obvious optimization to one of ordinary skill in the art, motivated by the desire to obtain a suitable solvent for making the polyketone filaments.

Allowable Subject Matter

5. Claims 1-3 are allowed (see Office action dated 11/10/2003).

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VSc
Victor S Chang
Examiner
Art Unit 1771

10/6/2004

Elizabeth M. Cole
ELIZABETH M. COLE
PRIMARY EXAMINER